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APPLICATION NO.		FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/740,749		12/22/2003	Shinichi Mihara	009523-0306805	3391	
909	7590	05/14/2004		EXAM	INER	
PILLSBUI	RY WIN	THROP, LLP	RAIZEN, DE	RAIZEN, DEBORAH A		
P.O. BOX 1 MCLEAN,		102	ART UNIT	PAPER NUMBER		
Wellin,	VII 221	. • •		2873		
				DATE MAILED: 05/14/2004		

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary The MAILING DATE of this communication appears on the cover sheet with the correspondence address eriod for Reply A HORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. - Enteriodies of time may be available under the provisions of 3° C/R*I 1.13(6). In rocent, however, may a right be firmly filled after 50.0 (30.00 ft. 15 min) in mine than this (70.00 ft.). - Enteriodies of time may be available under the provisions of 3° C/R*I 1.13(6). In rocent, however, may a right be filled filled by the considered timely. - HIND paned for right is specified allows, the near-main shallowy provided all publy and valid agric 30.0 (30.00 ft.) for the enabling date of the communication. - HIND paned for right is specified allows. The near-main shallowy provided all publy and valid agric 30.0 (30.00 ft.) for the enabling date of the communication, even if timely filled, may reduce day. - HIND paned for right is specified allows. The near-mains adding date of the communication, even if timely filled, may reduce day. - HIND paned for right is specified allows. - HIND paned for right is specified allows. - HIND paned for right is paned for the right of the communication, even if timely filled, may reduce day. - HIND paned for right is paned for the right of the communication, even if timely filled, may reduce day. - HIND paned for right is paned for the right of the communication, even if timely filled, may reduce day. - HIND paned for right is paned for the communication, even if timely filled, may reduce day. - HIND paned for right is paned for the communication, even if timely filled, may reduce day. - HIND paned for right is paned for the paned for the communication, even if timely filled, may reduce day. - HIND paned for right and paned for the right of the communication, even if timely filled, may reduce day. - HIND paned for right is paned for the right of the communication. - HIND paned for the paned for the paned for the p		Application No.	Applicant(s)					
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This action is FINAL. 2b This action is non-final. 3c) This action is FINAL. 2b This action is non-final. 3c) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213. Disposition of Claims 47 and 21-39 is/are pending in the application. 4a) Of the above claim(s) is/are ending in the application. 4a) Of the above claim(s) is/are eventually is/are withdrawn from consideration. 5c) Claim(s) is/are ellowed. 6c) Claim(s) is/are ellowed. 6c) Claim(s) is/are eljected. 7c) Claim(s) is/are eljected. 7c) Claim(s) is/are objected to . 7c) The specification is objected to by the Examiner. 7c) The graph of the drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner. 7c) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner. 7c) 7c	 THE MAILING DATE OF THIS COMMUNICATION. Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. If the period for reply specified above is less than thirty (30) days, a reply If NO period for reply is specified above, the maximum statutory period verailure to reply within the set or extended period for reply will, by statute. Any reply received by the Office later than three months after the mailing 	36(a). In no event, however, may a reply be ting within the statutory minimum of thirty (30) day will apply and will expire SIX (6) MONTHS from a cause the application to become ABANDONE	nely filed s will be considered timely. the mailing date of this communication. D (35 U.S.C. § 133).					
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S) Information disclosure statement(s) (1 10-1443 of 1 10-08500)	Attachment(s) 1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail D	Date					
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Application/Control Number: 10/740,749

Art Unit: 2873

DETAILED ACTION

Election/Restrictions

- 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 4-7, 21-23, 29-39 drawn to a zoom lens system comprising five lens groups wherein focusing is carried out by movement of the fifth lens group, classified in class 359, subclass 684.
 - II. Claims 24-28, drawn to drawn to a zoom lens system comprising four lens groups, classified in class 359, subclass 686.
- 2. The inventions are distinct, each from the other because:
- 3. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because claims 4-7, for example, have allowable subject matter, as indicated in the first action in the parent application, paper number 5. The subcombination has separate utility such as in cameras disclosed in subclass 686, wherein zoom lenses have four lens groups.
- 4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. A telephone call was made to Henry Daley on May 11, 2004, to request an oral election to the above restriction requirement, but did not result in an election being made.

Comment

If Invention I is elected, prosecution of the current application and of a subsequent divisional application could be greatly simplified by cancellation of claim 35 and by amendment of claim 39 so as to remove the dependency on claims 24-28 and 35.

Claim 35 has two mutually exclusive limitations that place the claim in two different species (as explained in a restriction requirement that was made in the parent application). If it remains in the case it will be rejected under 35 U.S.C. 112, first paragraph (the original disclosure does not meet written description and enablement) and second paragraph (the claim is indefinite because it is impossible for one embodiment to satisfy both limitations).

Claim 39 does not have antecedent basis for the limitation "the fifth lens group" in claims 24-28, so that it will be rejected under 35 U.S.C. 112, second paragraph. Also, it will be objected to as depending on claims directed to a non-elected invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah A. Raizen, Ph.D., J.D., whose telephone number is

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(571) 272-2336. The examiner can normally be reached on Monday-Friday, from 10:00 a.m. to 3:00 p.m. Eastern Standard Time (a part-time schedule).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The USPTO central official fax number is (703) 872-9306 (please note that this number is different from the previous two numbers provided until the summer of 2003).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications. External customers should be directed to EBC representatives, who can be reached at 703-305-3028 or toll free at 866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at: ebc@uspto.gov. Additional information is available on the Patent EBC Web site at: http://www.uspto.gov/ebc/index.html.

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Scott J. Sugarman Primary Examiner